



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,830	12/28/2001	Steve Filipski	58165-5001	9704

7590

05/08/2002

JEFFER, MANGELS, BUTLER & MARMARO LLP
Tenth Floor
2121 Avenue of the Stars
Los Angeles, CA 90067

EXAMINER

KRISHNAN, GANAPATHY

ART UNIT

PAPER NUMBER

1623

DATE MAILED: 05/08/2002

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/038,830

Applicant(s)

FILIPSKI ET AL.

Examiner

Ganapathy Krishnan

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Detailed Action

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 14, 15 and 16 are drawn to a method in claim 9 wherein the composition contains alkaloid-heavy extracts, sun block and a hydration time of one to sixty seconds for the hair.

Claims 14, 15 and 16 are method claims, which refer to claim 9, which is a composition claim. Since the two are different, it is not clear which type of claim the applicant regards as his invention.

Claim 26 and 28 contain the trademark/trade name Mach3. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a

Art Unit: 1623

trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a razor blade and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et.al (EP 0339634) in combination with Lentini et.al (USPN 5,665,368), Stoner et.al (USPN 5,902,574), George et.al (USPN 5,500,211), Cohen et al (USPN 5,560,917), Berger (USPN 5,008,293), Soler et al (USPN 6,113,926), Ha et al (USPN 5,997,887), Chekroun (EP 0554 322 B1), and McAtee et al (USPN 5,811,111).

Claims 1-11 are drawn to shaving and moisturizing compositions comprising water, humectant, silicone lubricant, sodium hyaluronate, PEG8 dimethicone, conditioner, preservative, allantoin, panthenol, chlorphenesin, Canadian willow herb extract, licorice extract, olive leaf extract, polytetrafluoroethylene, in different combinations and different percentages.

Art Unit: 1623

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Smith teaches (pages 2-4) the composition of a shave gel composition comprising water (40-90%), a salt of hyaluronic acid preferably sodium (.01 to 5%), allantoin (.01 to 1%) botanical plant extracts, post foaming agents like 1,1,2,2-tetrafluoroethane and additional additives like perfumes, skin conditioners, preservatives and humectants. However, Smith does not teach the use of other ingredients and their percentages.

Stoner et al teach the use of humectants like polyalkylene glycols (5-50%, col 7, line 5-32), use of allantoin, panthenol, PEG-7 and silicones (col 5, lines 33-47) in the use of shaving cream preparations. However, Stoner does not mention any percentages of some of the ingredients.

Cohen et al teach the use of panthenol, and silicones (col. 6, lines 1-34) in the range of 0.5 to 13% in cosmetic applications.

Berger et al teach the use of chlorphenesin in topical applications to the skin (abstract) to mitigate irritation, sensitization and inflammation by administering in concentrations of about 0.1 to 10% (col. 8, lines 55-61). However, they do not teach the use of chlorphenesin in shaving creams.

Art Unit: 1623

Soler et al teach the use of willow herb extracts between 0.1 and 30 % (col3. lines 6-11) and allantoin between .05 and 2% (col.3, line 35) in topical formulations for cosmetic and pharmaceutical applications. However, they do not teach their use in shaving creams.

Ha et al teach the use of PEG's in about 5-15% (col. 28, lines 39-66 and col. 29, lines 1-20) and also anti-inflammatory agents of the licorice plant family, especially licorice extract and sunscreens and sunblocks (col. 31, lines 31-50) in skin care compositions but not specifically in shaving compositions.

Chekroun teaches the use of phenonip (about 0.13%, example 1) in dermic creams and lotions, but does not teach its use in shaving creams.

McAtee et al teach the use of about 0.1 to 20 % (col.15, lines 9-15) of micronized particulates of polymeric materials like Teflon (col. 16, 29-65) in compositions useful for the topical delivery of a wide variety of active ingredients (abstract). These micronized particles are useful for enhancing the cleansing effect of the said compositions (col. 15, lines 9-15). However, they do not teach the use of such particles in shaving creams.

Lentini et al teach the use of sunscreens (col.7, lines 1-6), sodium hyaluronate (col.8 lines 5-16) and phenonip (0.5%, col. 10, example 2) in sprayable compositions for topical applications to human skin and hair. However they do not teach the use of these in shaving creams.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Smith, Stoner, Cohen, Berger, Soler, Ha, Chekroun, McAtee, and Lentini et al given above to formulate a shaving and moisturizing composition containing all of the ingredients mentioned above.

Art Unit: 1623

An artisan with ordinary skill would have been motivated to try various combinations and varying percentages of the said ingredients for making shaving and moisturizing compositions, since the use of these ingredients and their percentages in topical and shaving gel applications is already set forth in the teachings given above.

Claims 12,13 and 17-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (USPN 5958394) in combination with White (US 4994265), Smith (EP 0339634) and Rucker (USPN 4178364)

Claims 12,13 and 17-24 are drawn to methods of shaving hair by applying a shave composition wherein time to soften hair is between one to two minutes, shaving immediately after applying shave composition and spreading residual composition on the shave area and further applying water to the surface area, applying a shave composition containing sodium hyaluronate and silicone lubricant, shaving using a multiple blade razor.

Smith teaches (5958394, col. 4, lines 50-55) a preshaving methodology wherein the hair is wetted with water for about 30 seconds and then applying a shaving composition. However, Smith does not teach the use of the shave composition for hydration of the hair.

White teaches (col.2, line 33-40) the use of a shave composition that does not require the use of soap. It also does not require the use of water since there is no soap residue left after shaving. However, Smith does not teach the use of shave composition wherein the residual shave composition can be spread on the shaving area after shaving is completed.

Smith (EP00339634) teaches the use of shaving composition containing sodium hyaluronate. Rucker teaches (col.1, line 57-65) the application of two liquid phases, water on the

Art Unit: 1623

surface to be shaved and a silicone lubricant on the razor whereby the razor cuts cleanly with little pull.

It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Smith, White and Rucker to figure out that:

a) shaving can be done first by applying the shave composition on the surface to be shaved, instead of water and shaving after one or two minutes wherein the shave composition itself acts as a hydrant.

b) moistening hair by wetting and allowing time for the hair to hydrate and soften and then apply shaving composition and shave.

c) apply shave composition to the shave area and shave immediately after applying the shave composition and use minimal water if necessary between each stroke.

d) apply shave composition, especially one without soap and rub any residual shave composition on the surface after shaving.

e) shaving hair with a razor, the razor being single blade or multiple blade. Since prior art mentions the use of razor for shaving, it is obvious that shaving can be done equally well by using a single blade or a multiple blade razor with an open flow design, with little resistance.

A person with ordinary skill in the art would have been motivated to try the said method of shaving since the said methods are separately set forth in the teachings of Smith, White and Rucker.

Art Unit: 1623

Claims 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (EP0339634) in combination with Cohen et al (USPN 5,560,917), McAtee et al (USPN 5,811,111) and Rauch (USPN 5461782).

Claims 25 and 27 are drawn to a shaving kit comprising a multiple blade razor, shaving composition containing sodium hyaluronate, a humectant, a silicone lubricant, polytetrafluoroethylene and water.

Smith (EP0339634) teaches the use of shaving compositions containing a salt of hyaluronic acid and water. Cohen et al (USPN 5,560,917), and McAtee et al (USPN 5,811,111) teach the use of compositions containing humectant, silicone lubricant and tetrafluoroethylene. However, these three patents do not teach the use of these compositions in a kit.

Rauch teaches the use of a shaving kit comprising a razor and shaving cream.

It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Smith, Cohen McAtee and Rauch to assemble a shaving kit with the said shaving composition and a razor. An ordinarily skilled artisan would have been motivated to do so since the method and components needed to put together a kit are set forth in the teachings of Smith, Cohen, McAtee and Rauch.

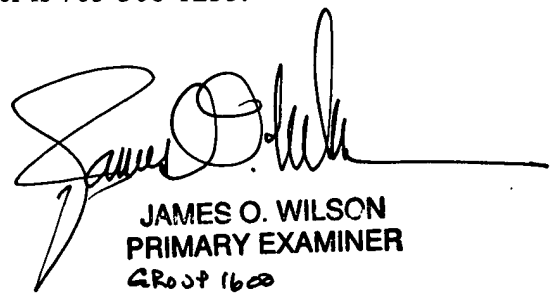
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ganapathy Krishnan whose telephone number is 703-305-4837. The examiner can normally be reached on 8.30am-5pm.

Art Unit: 1623

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 703-308-4532. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

GK
April 30, 2002



JAMES O. WILSON
PRIMARY EXAMINER
GROUP 1600